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Attorney's Docket No.: 10569-002001

REMARKS

This paper responds to the non-final Office Action mailed March 24, 2005. Claims 1-34 are pending, and each of the claims has been rejected. Applicant has amended claims 1, 8, 18, 19, 20, and 34 to more clearly point out the inventive features, and respectfully submits that the claims are now in condition for immediate allowance. Support for the amendments may be found in the original application, for example, at Figures 1, 4, 5, 6, and 7, and in the text at page 5, lines 7-32; page 7, line 16 to page 8, line 32; and page 12, line 11 to page 13, line 30. Applicant responds to each of the rejections below.

Rejection Under 35 U.S.C. § 103 over Sakayori in view of Luritsen

The Office Action rejects claims 1-4, 6-9, 11-14, 18, 20-24, and 27-34 as obvious over Japanese Patent No. 5-22428 to Sakayori et al. in view of U.S. Patent No. 5,570,025 to Lauritsen et al. Claims 1, 18, and 20 are the independent claims of this group. In various manners, each of these claims recites a device, such as a key, that both provides an alert of messages and retrieval of messages with a telephone or telephone set. The claims also recite various manners that make the device readily recognizable as something apart from the dialing keypad on the telephone or telephone set, so that the key may be located easily by a user who is not familiar with the telephone or telephone set. The original application emphasizes the importance of ready recognition in the context of a hospitality, or hotel-room telephone. In particular, guests in a hotel room are not generally familiar with a telephone, often have messages waiting when they return to the room, and often stumble around in low lighting (e.g., lighting from only the entry area of a room and perhaps a table lamp). See Application, page 7, line 30 to page 8, line 32. In such an environment, and in other similar environments, the claimed inventions—by providing, e.g., a lighted key, and by setting the key substantially apart from other keys—make the telephone especially easy to use. Also, by setting the key apart from the standard keypad, the telephone maker can use standard keypads, without having to make potentially expensive modifications of the keypad, and without having to adjust the roles that keys in the keypad normally serve.

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Neither reference cited in the office action teaches or even fairly suggests such an invention, and both lack the benefits of such an invention. Specifically, the Sakayori reference appears to disclose nothing more than the typical hotel or office telephone—with a message retrieval button that is wholly separate from a message waiting light. Thus, the telephone of Sakayori has the exact problems as the other prior art, as discussed in the present patent application—i.e., unfamiliar users have difficult determining quickly how to access messages, particularly in challenging environments. Tellingly, such phones have been around for years without anyone providing the solution recited in the pending claims.

The telephone discussed in the Lauritsen reference does nothing to fill the gap. Lauritsen simply shows a cellular telephone handset in which *one of the standard keypad buttons* (the “pound” key) is lighted and serves additional functions. While such an approach may work for a personal telephone whose features are well-understood by the user, it does not provide the advantages of providing a device separate from the keypad and in a manner that highlights the device (e.g., by making the device be spaced away from, or be larger and/or in a different shape than the twelve keypad keys). Thus, neither reference shows a combined notification and retrieval device, that is set apart from the keys in a telephone keypad. Because this feature is not disclosed or suggested by any reference, there cannot be an obviousness rejection.

Moreover, there is absolutely no motivation to combine the references. The Sakayori reference says nothing about using any approach other than what is disclosed there—the old approach of providing a message lamp separate from a message retrieval key. Likewise, the Lauritsen telephone is a cellular phone for which saving space would have been a top priority; thus, a skilled artisan reading Lauritsen would never have thought to add yet another key outside the standard keypad, as such an approach would increase the size of the telephone. The motivation that is suggested by the Office Action, at page 4, is plainly a hindsight reconstruction that uses the present invention to piece together the prior art, as the solution of helping the user find the message light in this way was conceived solely by the Applicant, and is recognized nowhere in the prior art.

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Moreover, even combined, the two references do not result in the claimed inventions. Rather, the combination would simply produce a telephone having a message retrieval device as part of the standard keypad, a message light away from the keypad, and a separate message retrieval key away from the keypad. Even apart from the confusion such a system would create, the combination would not produce the present claimed inventions, and would not produce the advantages of the present claimed inventions. The features of the claimed inventions simply are not a mere matter of design choice; they provide for functionality that has real and substantial advantages over the prior art.

The objective indicia of nonobvious also plainly show that the claimed inventions are patentable. Specifically, the claimed inventions are quickly becoming a standard in the hospitality telephone arena. For example, major hotel telephone supplier Teledex has recently rolled out such a feature in its iPhone line of telephones

(<http://www.teledex.com/telephones/hospitality/iphone/index.html>), apparently termed EasyTouch™.



Introducing iPhone from Teledex.
The first in a series of breakthrough designs.

The new iPhone™ from Teledex brings stunning new designs into the guest room. The iPhone A series delivers best-in-class quality of service in a high-tech look that enhances any guest room. Features a guest-friendly Courtesytel™ ascending ring, so your guests aren't jarred from their

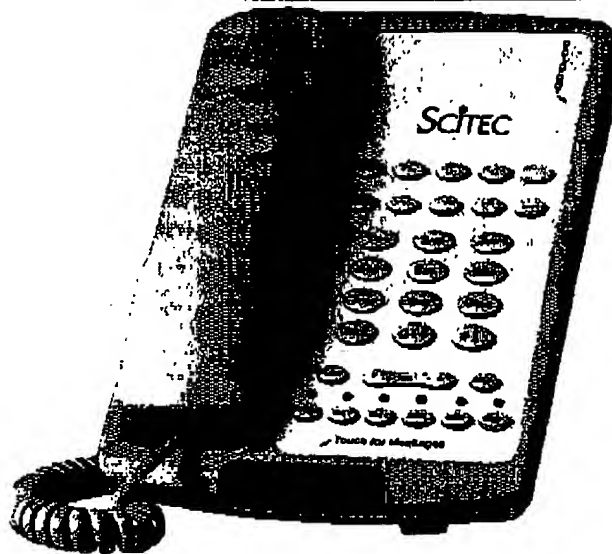
sleep needlessly. Easytouch™ voice mail retrieval from a bright red message waiting indicator. ExpressMail™ ready to accept Teledex's award winning high speed Internet add-ons. Built to the demanding standards of the world's longtime leader in hospitality telephones.

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Also, major telephone manufacturer Scitec has incorporated the features of the inventions into its 800 Series line of phones (<http://www.scitecinc.com/800.htm>), and includes a testimonial from the president of one customer focusing on the "key feature" that sold the phone, which allows hotel guests to "simply press the blinking lightbar to speed dial into voice mail" so they "don't have to search the telephone faceplate..." (<http://www.scitecinc.com/testimonials.htm>).



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Pacific Hospitality Group

"One-touch voice mail retrieval technology was the key feature that sold me on Scitec 600 phones. Our guests don't have to search the telephone faceplate or our services directory for dialing instructions. They simply press the blinking lightbar to speed dial into voice mail and then automatically listen to their messages on the speakerphone without ever picking up the handset. We continue to receive compliments from our guests, and the phones also interface well with our new Hitachi Telecom switch. These phones really are smart, and guest-friendly!"

Mr. John Savage
President
Pacific Hospitality Group

In addition, Protégé Hospitality has a similar feature designated E-Z Lite[®] Message Waiting: <http://www.protegehospitality.com/products/telephone.htm>. And the assignee of the present application has rolled out the inventions through its TouchLite[®] feature in various

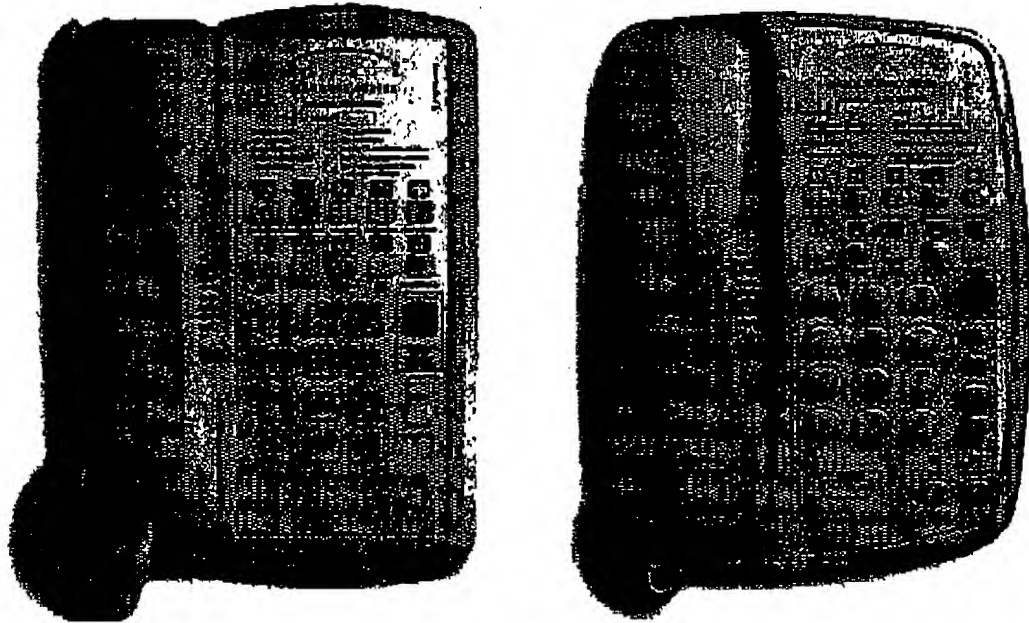
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hospitality and business implementations (see

<http://www.telematrixusa.com/TMXfolder/products/hospitality/marquis/>;

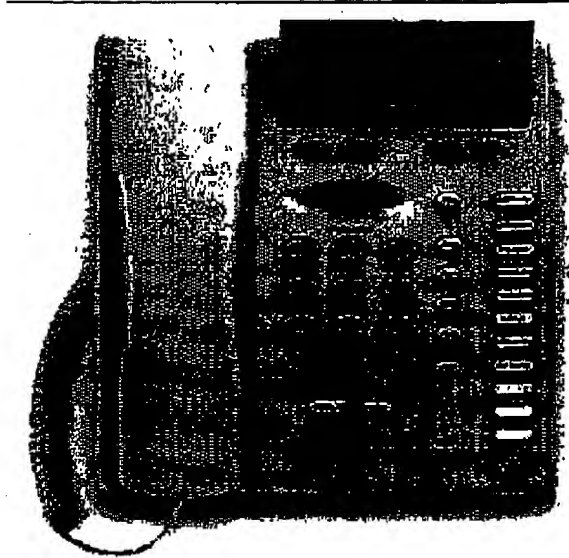
<http://www.telematrixusa.com/TMXfolder/products/commercialBusiness/spectrumPlus/>)



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The establishment of the presently claimed feature as a standard in the industry, for telephones having a need for voice mail retrieval (i.e., private phones, whether in a hotel room or in a person's office), and the commercial success of the invention as manufacturers sell more and more telephones incorporating it, are very strong evidence of nonobviousness. *See In re Hayes Microcomputer Prods., Inc. Patent Litigation*, 982 F.2d 1527 (Fed. Cir. 1992) ("[T]he commercial success of the invention, the failure of others to solve the problem addressed by the patented invention, and the fact that [an embodiment of the invention] has become the industry standard is *compelling objective evidence of the nonobviousness* of the claimed invention." (emphasis added)).

In sum, Applicant respectfully suggests that the inventions now claimed in the pending claims are neither disclosed nor suggested in the cited references, and requests allowance of the claims.

Rejection Under 35 U.S.C. § 103 over Lauritsen in view of Buhrmann

The Office Action rejects claim 19 as obvious over the Lauritsen patent in view of U.S. Patent 6,405,032 to Buhrmann. Claim 19 is an independent claim that, as amended, recites a voice message indicator that includes a key that is shaped differently than and larger than the

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dialing keys in the standard keypad. The key is also spaced away from the keys in the dialing pad. Thus, this claim recites a particular manner for making the difference between a combined indicating/speed dial key and the other keys—by making it larger than, and in a different shape than, the dialing keys. Thus, all of the reasons for patentability discussed above apply to claim 19.

In addition, the applied references do not teach or suggest anything about providing a combined key that is shaped differently from, and is larger than, the dialing keys. Such an arrangement makes the key particularly conspicuous to an unfamiliar user, such as a hotel guest, it is the particular implementation used by many of the real-world telephones discussed above, and it is not disclosed nor fairly suggested by the prior art. Applicant therefore requests allowance of claim 19.

Rejection Under 35 U.S.C. § 103 over Sakayori in view of Buhrmann and Christian

The Office Action rejects claim 5 as obvious over the Sakayori patent in view of the Lauritsen patent and U.S. Patent 4,363,936 to Buhrmann. Claim 5 depends on claim 1 and adds the feature of a speaker in the telephone housing to deliver voice mail messages to a user. For the reasons discussed above for claim 1, Applicant respectfully submits that claim 5 is also in condition for allowance.

Rejection Under 35 U.S.C. § 103 over Sakayori in view of Buhrmann and Burgess

The Office Action rejects claim 10 as obvious over the Sakayori patent in view of the Lauritsen patent and U.S. Patent 6,031,465 to Burgess. Claim 10 depends on claim 1 and recites that the message key is a membrane switch. For the reasons discussed above for claim 1, Applicant respectfully submits that claim 10 is also in condition for allowance.

Rejection Under 35 U.S.C. § 103 over Sakayori in view of Buhrmann and Charlier

The Office Action rejects claim 15 as obvious over the Sakayori patent in view of the Lauritsen patent and U.S. Patent 5,153,590 to Charlier. Claim 15 depends on claim 1 and recites

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that the light source comprises an LED and a light pipe assembly. For the reasons discussed above for claim 1, Applicant respectfully submits that claim 15 is also in condition for allowance.

Rejection Under 35 U.S.C. § 103 over Sakayori in view of Buhrmann and Akiyama

The Office Action rejects claim 16 as obvious over the Sakayori patent in view of the Lauritsen patent and U.S. Patent 5,153,906 to Akiyama. Claim 16 depends on claim 1 and recites that the light source comprises a matrix display assembly. For the reasons discussed above for claim 1, Applicant respectfully submits that claim 16 is also in condition for allowance.

Rejection Under 35 U.S.C. § 103 over Sakayori in view of Buhrmann and Kavanaugh

The Office Action rejects claim 17 as obvious over the Sakayori patent in view of the Lauritsen patent and U.S. Patent 6,223,233 to Kavanaugh. Claim 17 depends on claim 1 and recites that light source comprises a liquid crystal display element. For the reasons discussed above for claim 1, Applicant respectfully submits that claim 17 is also in condition for allowance.

Rejection Under 35 U.S.C. § 103 over Sakayori in view of Buhrmann and Kavanaugh

The Office Action rejects claim 25 and 26 as obvious over the Sakayori patent in view of the Lauritsen patent and U.S. Patent 5,612,995 to Corwith. Claim 26 depends on claim 25, while claim 25 depends on claim 24, which in turn depends on independent claim 20. Claim 24 recites a telephone communicating through a PBX, claim 25 recites that the message indicator light is line powered from the PBX line, and claim 26 recites the provision of a visual display that provides information about call status. For the reasons discussed above for claim 1, Applicant respectfully submits that claims 25 and 26 are also in condition for allowance.

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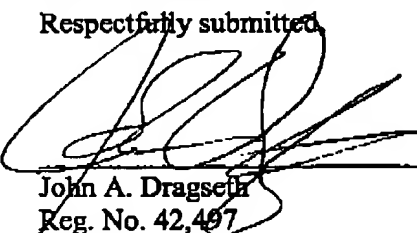
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Please charge Deposit Account No. 06-1050 in the amount of \$510 for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

9-26-05


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